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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/829,230	04/22/2004	Hideyuki Kinoshita	26112	7134
20529	7590	10/19/2006		
NATH & ASSOCIATES 112 South West Street Alexandria, VA 22314			EXAMINER SHEWAREGED, BETELHEM	
			ART UNIT	PAPER NUMBER

1774

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/829,230

Applicant(s)

KINOSHITA ET AL.

Examiner

Betelhem Shewareged

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) 8 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's response filed on 07/27/2006 has been fully considered. Claims 1-8 are pending. (NOTE: Claim 8 is withdrawn from consideration as non-elected invention). The Double Patenting rejections have been withdrawn in view of Applicant's comments.

Claim Rejections - 35 USC § 102

2. Claims 1-4, 6 and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Kawatsu et al. (US 6,025,286).

3. A stencil sheet comprises a fibrous support and a layer of polyester film (abstract, background art and claim 1). The fibrous support is equivalent to the claimed fiber layer, and the layer of polyester film is equivalent to the claimed layer. A layer of silicone based release agent is coated on the layer of polyester film (col. 8, line 11). The melting point of the layer of polyester film is 230 degree C or lower (col. 3, line 53). With respect to the value of the ratio of storage modulus, basis weight value and air permeability value, it is elementary that the mere recitation of newly discovered function or property, inherently possessed by things in the prior art, does not cause a claim drawn to those things to distinguish over the prior art. *In re swinehart et al.*, 169 USPQ 226 at 229. Since the Kawatsu reference teaches all of Applicant's claimed compositional and positional limitations, it is inherent that the reference article function in the same manner claimed by Applicant. The burden is upon Applicant to prove that

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the subject matter shown to be in the prior art does not possess the characteristic relied on.

Response to Arguments

4. Applicant's argument is based on the process of plate making of the master. This argument is not persuasive because the argument is directed to process limitation, while the claimed invention is directed to article. Applicant further argued that the claimed resin layer is different from the polyester film of the prior art because they have different property and function. This argument is not persuasive because ratio of storage modulus value, basis weight value and air permeability value are functional properties, and these properties are inherently possessed by the prior art. Applicant is advised to provide factual evidence to show that these properties cannot be possessed by the prior art. For the above reasons claims 1-4, 6 and 7 stand rejected.

Claim Rejections - 35 USC § 103

5. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kawatsu et al. (US 6,025,286).

6. Kawatsu does not expressly disclose a pore size value of the layer of polyester film. The experimental modification of this prior art in order to ascertain optimum operating conditions fails to render applicants' claims patentable in the absence of unexpected results. *In re Aller*, 105 USPQ 233. One of ordinary skill in the art would have been motivated to adjust the pore size in order to optimize ink permeability and

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enhance print quality. A prima facie case of obviousness may be rebutted, however, where the results of the optimizing variable, which is known to be result-effective, are unexpectedly good. *In re Boesch and Slaney*, 205 USPQ 215.

Response to Arguments

7. Applicant's argument is based on that Kawatsu gives no motivation to adjust the pore size, because its thermoplastic resin film primarily has no pores in it. This argument is not persuasive because the polyester film of Kawatsu has inorganic particles and it is stretched during process of making the stencil; therefore, the polyester film of Kawatsu may comprise pores.

Conclusion


8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Betelhem Shewareged whose telephone number is 571-272-1529. The examiner can normally be reached on Mon.-Fri. 8:00AM-4:30PM.

9. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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10. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

B.S.
October 15, 2006.


BETELHEM SHEWAREGED
PRIMARY EXAMINER